

Remarks

Claims 1-5 are currently pending in the Application.

35 U.S.C. §103(a) Rejection

Claims 1-5 stand rejected under 35 U.S.C. §103(a) as being obvious in view of Background of the invention.

Applicants submit that the Examiner has **not** established a *prima facie* case of obviousness for the claims rejected under 35 U.S.C. §103(a). Applicants note:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. **First, there must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. **Second, there must be a reasonable expectation of success**. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. **The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure**" (emphases added) MPEP §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit that a *prima facie* case of obviousness has not been established for the reasons set forth below.

Applicants submit that there is no suggestion or motivation to modify or to combine Figures 1A and 1B as shown below.

The Examiner fails to demonstrate some reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the cited references. Applicants submit that under MPEP §2143 "teaching or suggestion to make the claimed combination ... must ... be found in the prior art, **not** in applicant's disclosure" (emphasis added). Applicants respectfully submit that there is no suggestion or motivation in either Prior Art Figures 1A or 1B as to how the features of the two

devices could be combined so as to meet the structure as claimed in the present application. It has been found that “when the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. … Absent such reasons or incentives, the teachings of the references are not combinable” Ex parte Skinner, 2 USPQ2d 1788 (B.P.A.I. 1986). Applicants submit that the Examiner’s combination of Figures 1A and 1B is based upon a hindsight reconstruction of Applicant’s claims as opposed to what the figures really suggest.

Figure 1A discloses a conductive layer “28” covering a conductive channel composed of areas 23, 24 and 25. Figure 1B, on the other hand, discloses a conductive layer “28” only covering portions of non-conductive channel composed of areas 23, 25 and 27.

Applicants submit that one skilled in the art would not find any suggestion or motivation in the Figures 1A and 1B to combine or modify the two devices disclosed in the cited figures to meet the structure as claimed in the present application. Because Figure 1A teaches the use of a conductive channel and Figure 1B teaches the use of a non-conductive channel, where is the suggestion or what would be the motivation for one skilled in the art to combine or modify Figures 1A and 1B? Why would one skilled in the art combine a reference that teaches a conductive channel with the reference that teaches a non-conductive channel? Applicant submits that the only reason these figures were cited was because the Examiner used the present claims as a roadmap.

Applicants submit that the Examiner failed to comply with 37 C.F.R. §1.104(c)(2) which states:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes invention other than that claimed by Applicant, **the particular part relied on must be designated as nearly as practicable**. The pertinence, if not apparent, must be clearly explained and each rejected claim specified” (emphases added).

Applicants submit that the Examiner has failed to “designate as nearly as practicable” where Figures 1A and 1B provide any suggestion or motivation as to how to modify or to combine Figures 1A and 1B.

As stated by the Federal Circuit: “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.” *In re Fritch*, 972 F.2d 1260. Therefore, because Figures 1A and 1B do not provide any suggestion or motivation as to how to modify or to combine Figures 1A and 1B, the Examiner has **not** established a *prima facie* case of obviousness for the claims rejected under 35 U.S.C. §103(a).

Conclusion

In view of the above, reconsideration and allowance of all the claims are respectfully solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136 (a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents POB 1450, Alexandria, VA 22313-1450 on

August 1, 2005

(Date of Deposit)

Elizabeth A. McInerney

(Name of Person Signing)



August 1, 2005

(Date)

Respectfully submitted,



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